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| MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101 | | | WHIPKEY, JASON T | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/466,046

Applicant(s)

OHKUBO, TOSHIYUKI

Examiner

Jason T. Whipkey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed June 23, 2006, have been fully considered but they are not persuasive.

Regarding each of the claims, Applicant argues that Nakayama neither explicitly nor implicitly discloses a switch adapted to instruct the image capture apparatus to start a recording process to a recording medium. Applicant argues that because of this, Nakayama cannot disclose that an image is captured before the switch is operated. The examiner disagrees.

The disagreement may center on the definition of the word *capture*. The examiner is using the term to mean, "to receive and convert an image into an electrical signal." A cursory check of the specification did not result in locating the term for clarification.

Column 6, lines 20-24, discloses that an image received and converted into an electrical signal by the image pickup tube is used to adjust the white balance. The examiner maintains Nakayama's system is *capturing* an image of the scene and using it to adjust white balance (see column 6, lines 59-60).

The examiner also maintains that some sort of switch is present. In a moving-image camera (or "animated" camera; see column 7, lines 37-39), Nakayama teaches, "the white balance for a first shot is held at the first adjusted condition, and is then reset and readjusted for every subsequent shot of the recording run" (see column 6, line 66, through column 7, line 1). Since such a camera records separate shots, it is inherent that there is some sort of switch present that instructs the camera to begin a shot.

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In a still-picture camera (see column 7, lines 50-55), independent images are captured. Since the device will need some sort of trigger to indicate when an image has been suitably composed, it is inherent that some sort of switch is present; otherwise, the camera cannot know when an image is to be captured.

For these reasons, the rejection stands.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 45, 50, 56, and 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Udagawa (U.S. Patent No. 6,982,753).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

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inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding **claims 45 and 56**, Udagawa discloses an image capture apparatus (see Figure 1) comprising:

an image capture unit (CCD 2) adapted to capture an image using an image pickup element;

a switch (SW2) adapted to instruct the image capture apparatus to start a recording process of recording a captured image to a recording medium (see column 4, lines 9-11); and

a control unit (system controller 6) adapted to control the recording process (image recording is not permitted to occur until white balance coefficients WBsw1 and WBsw2 are both calculated, and then the image to be recorded is produced using those coefficients; see column 4, lines 52-54 and 61-65), using a first white balance value (WBsw1) indicating a white balance of an image captured before the switch is operated (a white balance coefficient is calculated during the interval between the depression of SW1 and SW2; see column 4, lines 48-54) and a second white balance value (WBsw2) indicating a white balance of an image captured after the switch is operated (see column 4, lines 61-65).

Regarding **claims 50 and 60**, Udagawa discloses that image recording is not permitted to occur until white balance coefficients WBsw1 and WBsw2 are both calculated (see column 4, lines 52-54 and 61-65).

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4. Claims 63 and 67 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakayama (U.S. Patent No. 4,750,032).

Regarding **claims 63 and 67**, Nakayama discloses an image capture apparatus (see Figure 1) comprising:

an image capture unit (image pickup tube 4) adapted to capture an image using an image pickup element; and

a switch adapted to instruct the image capture apparatus to start a recording process of recording a captured image to a recording medium (as described in column 5, lines 36-47, a white balance must be set prior to image recording. Since a warning is produced if the white balance of the image being recorded changes from its initial level, it is inherent that some sort of user-activated switch is present that begins recording — otherwise, the device has no way of knowing that the initial level setting is complete and that a white balancing deviation from said level has occurred),

wherein the image capture apparatus is capable of determining whether to issue a warning to a user or not using a first white balance value indicating a white balance of an image captured before the switch is operated and a second white balance value indicating a white balance of an image captured after the switch is operated (see *id.*).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 43, 49, 53, and 55 are rejected under 35 U.S.C. 103(a) as being obvious over Kimura (U.S. Patent No. 4,890,166) in view of Shiokawa (Japanese Publication No. 60-220671) and Udagawa (U.S. Patent No. 6,982,753).

The applied Udagawa reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding **claims 43 and 53**, Kimura discloses an image capture apparatus (see Figure 1), comprising:

an image capture unit (CCD sensor 8) adapted to capture an image using an image pickup element;

a switch (SW2) adapted to instruct the image capture apparatus to start a recording process of recording a captured image to a recording medium (see column 4, lines 3-4); and

a control unit (sequence control circuit 2) adapted to control the apparatus using (c) a first exposure value (EV1) indicating an exposure of an image captured (see column 4, lines 19-21) before the switch is operated (as shown in the flowchart of Figure 3, EV1 is calculated in step 102, which is prior to the closing of SW2 in step 105) and (d) a second exposure value (EV2) indicating an exposure of an image captured after the switch is operated (namely, in step 109).

While Kimura calculates the difference between the two exposure values prior to recording an image (see step 110), Kimura is silent with regard to controlling the recording process based on the two exposure values.

Shiokawa discloses an electronic still camera that prevents the recording of a picture when an exposure value is too far out of range from a prescribed exposure value (see abstract).

An advantage of controlling recording of an image based on two exposure values is that storage space will not be wasted by storing images with an unstable or unacceptable exposure level. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Kimura's imaging device control recording based on two exposure values.

Both Kimura and Shiokawa are silent with regard to controlling the recording process using first and second white balances.

Udagawa discloses an image capture apparatus (see Figure 1) comprising:

a control unit (system controller 6) adapted to control the recording process (image recording is not permitted to occur until white balance coefficients WBSw1 and WBSw2 are both calculated, and then the image to be recorded is produced using those coefficients; see column 4, lines 52-54 and 61-65), using a first white balance value (WBSw1) indicating a white balance of an image captured before the switch is operated (a white balance coefficient is calculated during the interval between the depression of SW1 and SW2; see column 4, lines 48-54) and a second white balance value (WBSw2) indicating a white balance of an image captured after the switch is operated (see column 4, lines 61-65).

As stated in column 5, lines 3-8, an advantage of controlling recording based on the two white balance values is that color correction can be performed rapidly because the camera will be ready when the user presses the shutter button. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Kimura's device control recording based on white balance values.

Regarding **claims 49 and 55**, Kimura is silent with regard to starting the recording process based on the two exposure values.

Shiokawa discloses an electronic still camera that prevents the recording of a picture when an exposure value is too far out of range from a prescribed exposure value (see abstract).

An advantage of controlling recording of an image based on two exposure values is that storage space will not be wasted by storing images with an unstable or unacceptable exposure

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level. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Kimura's imaging device control recording based on two exposure values.

Kimura is also silent with regard to starting the recording process based on two white balance values.

Udagawa discloses that image recording is not permitted to occur until white balance coefficients WBSw1 and WBSw2 are both calculated (see column 4, lines 52-54 and 61-65).

An advantage of controlling recording of an image based on two white balance values is that storage space will not be wasted by storing images with unstable white balance values. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Kimura's imaging device control recording based on two white balance values.

7. Claims 44 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura in view of Shiokawa and Udagawa and further in view of Aihara (Japanese Patent Application Publication No. 62-023025) and Nakayama.

Claims 44 and 54 may be treated like claims 43 and 53, respectively. However, Kimura, Shiokawa, and Udagawa are all silent with regard to issuing a warning using the exposure values and white balance values.

Aihara discloses a camera that compares two brightness levels calculated while the camera is in an auto-exposure mode (see abstract). Display driving circuit 35 is used to warn a user when such a difference is greater than a predetermined amount (see abstract).

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As stated in the abstract, an advantage of performing such a warning is that an improper exposure may be prevented. For this reason, it would have been obvious to have Kimura's and Shiokawa's imaging devices provide an exposure warning to a user.

Nakayama discloses:

wherein the image capture apparatus is capable of determining whether to issue a warning to a user or not using a first white balance value indicating a white balance of an image captured before the switch is operated and a second white balance value indicating a white balance of an image captured after the switch is operated (see column 5, lines 36-47).

An advantage of issuing a warning to a user is that recording of an image with erroneous color can be prevented. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Kimura's system warn a user based on white balance values.

8. Claims 46 and 57 rejected under 35 U.S.C. 103(a) as being unpatentable over Udagawa in view of Nakayama.

Claims 46 and 57 may be treated like claims 45 and 56, respectively. However, Udagawa is silent with regard to determining whether to issue a warning to a user based on the white balance values.

Nakayama discloses:

wherein the image capture apparatus is capable of determining whether to issue a warning to a user or not using a first white balance value and a second white balance value (see column 5, lines 36-47).

An advantage of issuing a warning to a user is that recording of an image with erroneous color can be prevented. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Udagawa's system warn a user based on white balance values.

9. Claims 47 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Udagawa in view of Kimura and Shiokawa.

Claims 47 and 58 may be treated like claims 45 and 56, respectively. However, Udagawa is silent with regard to controlling the recording process using two exposure values.

Kimura discloses an image capture apparatus (see Figure 1), comprising:

a control unit (sequence control circuit 2) adapted to control the apparatus using a first exposure value (EV1) indicating an exposure of an image captured (see column 4, lines 19-21) before the switch is operated (as shown in the flowchart of Figure 3, EV1 is calculated in step 102, which is prior to the closing of SW2 in step 105) and a second exposure value (EV2) indicating an exposure of an image captured after the switch is operated (namely, in step 109).

An advantage of controlling a recording process using the two exposure values is that the camera can ensure that the exposure settings are stable prior to image capture. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Kimura's imaging apparatus use two exposure values to control the recording process.

While Kimura calculates the difference between the two exposure values prior to recording an image (see step 110), Kimura is silent with regard to controlling the recording process based on the two exposure values.

Shiokawa discloses an electronic still camera that prevents the recording of a picture when an exposure value is too far out of range from a prescribed exposure value (see abstract).

An advantage of controlling recording of an image based on two exposure values is that storage space will not be wasted by storing images with an unstable or unacceptable exposure level. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Kimura's imaging device control recording based on two exposure values.

10. Claims 48 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Udagawa in view of Kimura and Shiokawa and further in view of Aihara.

Claims 48 and 59 may be treated like claims 47 and 58, respectively. However, Kimura and Shiokawa are silent with regard to issuing a warning to a user based on the exposure values.

Aihara discloses a camera that compares two brightness levels calculated while the camera is in an auto-exposure mode (see abstract). Display driving circuit 35 is used to warn a user when such a difference is greater than a predetermined amount (see abstract).

As stated in the abstract, an advantage of performing such a warning is that an improper exposure may be prevented. For this reason, it would have been obvious to have Kimura's and Shiokawa's imaging devices provide an exposure warning to a user.

11. Claims 61 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura in view of Aihara and Nakayama.

Regarding **claims 61 and 65**, Kimura discloses an image capture apparatus, comprising:

an image capture unit (CCD sensor 8) adapted to capture an image using an image pickup element;

a switch (SW2) adapted to instruct the image capture apparatus to start a recording process of recording a captured image to a recording medium (see column 4, lines 3-4);

wherein the image capture apparatus operates using (a) a first exposure value (EV1) indicating an exposure of an image captured (see column 4, lines 19-21) before the switch is operated (as shown in the flowchart of Figure 3, EV1 is calculated in step 102, which is prior to the closing of SW2 in step 105) and (b) a second exposure value (EV2) indicating an exposure of an image captured after the switch is operated (namely, in step 109).

Kimura is silent with regard to determining whether to issue a warning to a user based on the exposure values.

Aihara discloses a camera that compares two brightness levels calculated while the camera is in an auto-exposure mode (see abstract). Display driving circuit 35 is used to warn a user when such a difference is greater than a predetermined amount (see abstract).

As stated in the abstract, an advantage of performing such a warning is that an improper exposure may be prevented. For this reason, it would have been obvious to have Kimura's and Shiokawa's imaging devices provide an exposure warning to a user.

Kimura is silent with regard to determining whether to issue a warning to a user based on the white balance values.

Nakayama discloses:

wherein the image capture apparatus is capable of determining whether to issue a warning to a user or not using a first white balance value and a second white balance value (see column 5, lines 36-47).

An advantage of issuing a warning to a user is that recording of an image with erroneous color can be prevented. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Kimura's system warn a user based on white balance values.

12. Claims 62 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura in view of Aihara and Nakayama and further in view of Shiokawa and Udagawa.

Claims 62 and 66 may be treated like claims 61 and 65, respectively. However, Kimura is silent with regard to starting the recording process based on the two exposure values.

Shiokawa discloses an electronic still camera that prevents the recording of a picture when an exposure value is too far out of range from a prescribed exposure value (see abstract).

An advantage of controlling recording of an image based on two exposure values is that storage space will not be wasted by storing images with an unstable or unacceptable exposure level. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Kimura's imaging device control recording based on two exposure values.

Kimura is also silent with regard to starting the recording process based on two white balance values.

Udagawa discloses that image recording is not permitted to occur until white balance coefficients WBSw1 and WBSw2 are both calculated (see column 4, lines 52-54 and 61-65).

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An advantage of controlling recording of an image based on two white balance values is that storage space will not be wasted by storing images with unstable white balance values. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Kimura's imaging device control recording based on two white balance values.

13. Claims 64 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama in view of Udagawa.

Claims 64 and 68 may be treated like claims 63 and 67, respectively. However, Nakayama is silent with regard to determining whether to start the recording process using the white balancing values.

Udagawa discloses that image recording is not permitted to occur until white balance coefficients WBsw1 and WBsw2 are both calculated (see column 4, lines 52-54 and 61-65).

An advantage of controlling recording of an image based on two white balance values is that storage space will not be wasted by storing images with unstable white balance values. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Nakayama's imaging device control recording based on two white balance values.

Conclusion

14. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art

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of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Whipkey, whose telephone number is (571) 272-7321. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:30 P.M. eastern daylight time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava, can be reached at (571) 272-7304. The fax phone number for the organization where this application is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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August 10, 2006



VIVEK SRIVASTAVA
PRIMARY EXAMINER